

Serial No. 10/622,299

Docket No. CR44U-US**REMARKS****Status of Claims**

Claims 1, 5-14, and 21-29 are pending in the application.

Claims 1, 5-14, and 21-29 stand rejected.

Claims 1 and 14 are amended.

Amendments to the Claims

Claims 1 and 14 are amended herein to remove the language "whercin a colored pigment is bonded to said bismuth oxychloride in said pearlescent component" and instead recite "a pearlescent component comprising a bismuth oxychloride-containing pearlescent ingredient bonded to a colorant" for the sake of simplifying the claim language.

Claim 1 has also been amended herein to require that the "pearlescent component matches in shade a natural skin tone benchmark shade" and to require a "pigment component that also matches in shade said benchmark shade."

These amendments do not alter the scope of the claims and are therefore considered purely cosmetic. No new matter is introduced by the amendments.

Claim Rejections

The Examiner has rejected claims 1 and 5-12 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,800,816 ("Breiva"), claims 1 and 5-9 under § 102(e) as anticipated by U.S. Patent No. 6,372,202 ("Simon"), claims 1, 5-10, 13, 14, 21-26, and 29 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,511,672 ("Tan"), and claims 27 and 28 under 35 U.S.C. § 103 as obvious over Tan in view of Brieva. Applicants submit that all of these rejections are deficient because none of the references, alone or in combination, teach or suggest even the most basic aspects of the present claims, including: (1) a shade-matched pearlescent component and a separately shade-matched pigment component; or (2) a bismuth oxychloride-containing pearlescent ingredient which is bonded to a colorant.

Briefly, Applicants' invention is directed to a combination of a pigment that is shade-matched to a benchmark shade, and a pearlescent ingredient that is shade-matched to a

Serial No. 10/622,299

Docket No. CR44U-US

benchmark shade. As explained in the instant specification, the inventors have discovered that when a pearlescent component is also separately shade-matched in addition to the shade-matched pigment component, "the resultant colored cosmetic mimics healthy skin's natural glow more accurately than any heretofore commercial colored cosmetic product." (see page 12). This effect is not achieved by solely shade-matching the pigment. None of the art cited by the Examiner even remotely suggests shade matching a pearlescent component in addition to shade matching a pigment component. Further, the pearlescent component of the present claims comprises a bismuth oxychloride-containing ingredient which is bonded to a colorant. None of the references cited by the Examiner teach or suggest bonding a colorant to a pearlescent ingredient, let alone shade matching such a component to a benchmark tone. For at least these reasons, Applicants submit that the instant claims fully distinguish the art of record and respectfully request reconsideration of every rejection.

The distinctions between Applicants' invention and the cited references are discussed more fully below. However, as an initial matter, Applicants address the Examiner's contention that the shade-matching language of the claims is afforded no patentable weight. The Examiner contends that the language "wherein said pearlescent component is matched to a natural skin tone benchmark shade" and "a pigment component that is separately shade-matched to said benchmark shade" of claim 1 are product-by-process limitations which do not substantively limit the claims. Applicants disagree.

First, claim 1 does not require any step of shade-matching. Rather, the claim specifies the pigments which are useful according to the invention as those that match a benchmark shade. This does not require an active step of shade-matching because suitable pigments will already possess that property and thus will be distinguished from all other pigments. Moreover, even in a strained reading of the claims as containing product-by-process limitations, shade-matching would still be a substantive limitation on the scope of the claims because a step of shade-matching imparts a unique property to the resultant pigment or pearlescent component which distinguishes those pigments and pearlescent components from all others. See MPEP § 2113 ("The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art."). Regardless of whether the Examiner considers shade-matching to entail a process step, the pigment itself

Serial No. 10/622,299

Docket No. CR44U-US

having the properties of being shade-matched to a benchmark shade must be considered in determining the patentability of the claim.

Nevertheless, claim 1 has been amended herein to require that the "pearlescent component matches in shade a natural skin tone benchmark shade" and also to require a "pigment component that also matches in shade said benchmark shade." These amendments to claim 1 are clearly not in the nature of a process step. Applicants therefore request that the claim rejections be reconsidered in view of these substantive limitations.

U.S. Patent No. 5,800,816 ("Breiva")

The Examiner has rejected claims 1 and 5-12 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,800,816 ("Breiva"). The Examiner states that Breiva discloses "compositions for topical application to skin comprising a pearlescent component bismuth oxychloride, and organic pigments...and inorganic pigments." Further, the Examiner contends that the "colored pigment is bonded to bismuth oxychloride." Applicants traverse this ground of rejection.

While Breiva discloses compositions that may include both bismuth oxychloride and pigments, there is absolutely no teaching or suggestion that the pigments are of a shade that matches a benchmark tone or that the bismuth oxychloride component is also of a shade that matches the same benchmark tone. For this reason alone, Breiva cannot anticipate the instant claims.

Furthermore, contrary to the Examiner's contention, Breiva does not disclose a pearlescent ingredient bonded to a colorant. The Examiner states that "Breiva comprises a colored pigment and bismuth oxychloride, and thus will inherently contain a colored pigment bonded to bismuth oxychloride." The Examiner, however, offers no rationale as to why the colored pigment of Breiva would inherently be bonded to the to bismuth oxychloride. As required by M.P.E.P. § 2112 (IV), "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." The Examiner has not done so.

Serial No. 10/622,299

Docket No. CR44U-US

In fact, it is clear from the disclosure of Breiva that the pigment component is not bonded to the bismuth oxychloride. For instance, Example 5 of Breiva discloses an eye shadow comprising 4.49 % by weight bismuth oxychloride in combinations with several pigments, including 4.00 % titanium dioxide, 0.15% black iron oxide, 0.35% yellow iron oxide, and 0.6% red iron oxide. Each of these pigments is listed in Example 5 as a separate ingredient from the bismuth oxychloride. Further, the pigments and bismuth oxychloride are stated to be "dry particulate matter" [col. 4, lines 56-60; col. 5, lines 14-15]. Hence, the Examiner's position is similar to arguing that in a blend of powdered salt and powdered sugar, the salt and sugar are bonded to one another. Obviously, that is not the case. Similarly, there is simply no reason to conclude that pigments of Breiva are bonded to the bismuth oxychloride component. For at least these reasons, Applicants submit that the present claims fully distinguish over Breiva and respectfully request withdrawal of this ground of rejection.

U.S. Patent No. 6,372,202 ("Simon")

Claims 1 and 5-9 stand rejected under § 102(e) as anticipated by U.S. Patent No. 6,372,202 ("Simon"). The Examiner states that "Simon discloses a colored cosmetic compositions for topical application comprising pearlescent agents, such as mica covered with bismuth oxychloride, and pigments" and argues that the bismuth oxychloride is inherently bonded to a colorant. Applicants traverse this ground of rejection.

While Example 2 of Simon does disclose a composition comprising bismuth oxychloride and a pigment, there is no teaching or suggestion that these components are shade-matched to a particular benchmark tone. For this reason alone, Simon does not anticipate the instant claims.

Further, there is no teaching or suggestion whatsoever that the bismuth oxychloride is bonded to a colorant. Again, the Examiner states that this is an inherent feature of Example 2 of Simon but offers no rationale as to why the bismuth oxychloride component would inherently form a bond with the colorant as required by M.P.E.P. § 2112 (IV). Applicants submit that a plain reading of Simon reveals that the pigments and the bismuth oxychloride are separate ingredients and there is no reason whatsoever to conclude that they are bonded to one another. For at least these reasons, Applicants submit that the present claims fully distinguish over Simon and request withdrawal of this ground of rejection.

Serial No. 10/622,299

Docket No. CR44U-USU.S. Patent No. 6,511,672 ("Tan")

Claims 1, 5-10, 13, 14, 21-26, and 29 stand rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,511,672 ("Tan"), and claims 27 and 28 under 35 U.S.C. § 103 stand rejected as obvious over Tan in view of Brieva. Specifically, the Examiner states that Tan discloses compositions comprising "a first platelet of alumina treated with metal oxide such as iron-oxide, a second platelet can be selected from...bismuth oxychloride..." The Examiner further contends that "[i]t is disclosed that the two platelets together form the mosaic which gently reflects light and matches the natural color of the skin i.e. the pearlescent component is matched to a natural skin tone." Applicants traverse this ground of rejection, as the instant claims are neither anticipated by, nor obvious over Tan.

The Examiner's conclusion that "the pearlescent component is matched to the natural skin tone" is unfounded. As the Examiner points out, Tan discloses that together the two different platelets match the natural color of the skin [col. 3, lines 34-36]. However, there is no teaching or suggestion that the individual components of the compositions of Tan are individually shade-matched to any particular benchmark tone. The instant composition claims require that a pearlescent component match a benchmark tone and a pigment component also match the same benchmark tone. Tan does not teach or suggest such a composition. In fact, Tan teaches away from such a composition. Specifically, Tan states that the alumina-based metallic pigment "does not match skin tone" and that "these pigments alone are not suitable for a foundation that matches the natural tone of the skin" [col. 3, lines 40-45]. Accordingly, one skilled in the art would not have been motivated by Tan to separately match the pigment component of the first platelet to a benchmark tone, especially a skin tone, because Tan teaches against separate shade-matching and states that only the combination of the pigment containing platelet and the other [bismuth oxychloride] platelet component can be matched to skin tone. Therefore, applicants submit that independent claims 1 and 14 are neither anticipated nor obvious over Tan.

The Examiner also contends that the composition disclosed by Tan "comprises a colored pigment i.e. alumina platelet treated with iron-oxide and bismuth oxychloride, and thus will inherently contain a colored pigment bonded to bismuth oxychloride." This is clearly not the case. The "alumina treated with metal oxide" platelet to which the Examiner refers is the

Serial No. 10/622,299

Docket No. CR44U-US

"first platelet" [col. 3, lines 31-32], whereas the bismuth oxychloride-containing platelet is the "second platelet" [col. 4, lines 20-21]. The first and second platelets are said to be "blended" together. Accordingly, Applicants fail to see how this situation would produce a pearlescent ingredient bonded to a colorant. Certainly, the Examiner has not met the initial burden of providing some scientific or technical rationale as to why these components would be bonded to one another, despite the fact that they are present in separate platelets. For this additional reason, the rejections over Tan are deficient.

The Examiner has rejected claims 27 and 28 under 35 U.S.C. § 103 as obvious over Tan in view of Breiva. Applicants submit that claims 27 and 28 fully distinguish over Tan and Breiva, alone or in combination, for the same reasons as claim 14, from which these claim ultimately depend. Applicants reserve the right to address the particulars of this rejection, if necessary, in the future.

CONCLUSION

Applicants respectfully submit that the instant application is in condition for allowance. Entry of the amendments and an action passing this case to issue is therefore respectfully requested. In the event that a telephone conference would facilitate examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,

Dated: 5/20, 2007By: Joan M. McGillicuddy
Registration No. 35,608Correspondence Address:Avon Products, Inc.
Avon Place
Suffern, New York 10901(845) 369-2114 Telephone
(845) 369-2900 Fax